

PRELIMINARY REMARKS

Examiner has rejected Claims 1,4 under 35 U.S.C. 102(b) as being anticipated by Ishida, U.S. Patent 5,434,508 (hereinafter, Ishida) and as being anticipated by Anderson, U.S. Patent 6,078,871 (hereinafter, Anderson). Examiner has also rejected Claims 1-9 as being unpatentable over Lane, et al., U.S. Patent 6,502,044 (hereinafter, Lane) in view of Anderson in the Office Action Summary.

APPLICANT'S REMARKS

Applicant has provided a complete set of all pending Claims as per the new format. Applicant has canceled Claims 1 and 4, thus rendering moot Examiner's rejections on the basis of 35 U.S.C. §102(b). Applicant has amended Claim 9 to improve the syntax and cadence. It is believed no new matter has been added. Also, Applicant has newly added Claims 10-13 to afford more protection for Applicant's inventive contribution to the art. Applicant believes no new matter has been added. Applicant has responded to each of Examiner's assertions rendering the basis for the 35 U.S.C. §103(a) rejection moot. In view of such, Applicant respectfully requests removal of all rejections, reconsideration all claims, and a timely notice of allowance to optimize Applicant's statutory patent term.

Rejections Under 35 U.S.C. 103

The Examiner has used the obviousness rejection, relying upon Lane in view of Anderson, pointing to a supposed motivation for combining those references. It is respectfully submitted that this remains an insufficient ground for rejection.

Here, in applying the Lane and Anderson, the Examiner has cited references which are not properly combinable for reasons which will be made clear in the pursuing discussion. As per MPEP 2143.01, the Examiner's proposed modification cannot render the prior art unsatisfactory for its intended purpose. On this basis, it is submitted that the Examiner has failed to properly present a *prima facie* case of obviousness with respect to the Claims 2-3, 5-9.

Applicants' understanding of the Examiner's application of Lane and Anderson is that the apparatus, including the power supply, disclosed in Lane is to be used with the display of Anderson to display the battery's power consumption.

(1) The Proposed Modification cannot change the Principle of operation of Lane

Applicants respectfully assert that the Examiner has failed to properly establish a *prima facie* case of obviousness, as will be shown for Applicant's claims 2-3 and 5-9. Examiner's statement of motivation is improper because a person of ordinary skill in the art would not combine the teachings related to the apparatus and power supply of the primary reference Lane modified to use the display as taught by Anderson to arrive at Applicant's claimed apparatus for the following reasons (a) the apparatus of Lane's teachings shuts down microprocessor(18) once emergency power is supplying power to the lamps, and (b) if the microprocessor(18) of Lane's apparatus remains powered during emergency operation, the desired duration for emergency lighting will not be achieved. Support for these assertions are respectfully submitted and explained in further detail hereinbelow.

(2) The Proposed Modification cannot change the Principle of operation of Anderson

Examiner's proposed combination of Lane and Anderson changes the operation of Anderson. Lane's invention teaches that the emergency lighting device or fixture utilizes the circuitry of Figure 1 to periodically test the emergency readiness of the device, and monitor and control the charging of the emergency power supply, i.e. the batteries (22). The intended use of the circuitry (10) is for diagnosing the emergency readiness of the backup batteries and lamps while in a non-emergency state of operation, while operating under AC utility power. Once emergency power is activated (loss of AC utility power) the circuitry is used to control the initiation of emergency power to the emergency lamps, then disable as much circuitry as possible including the microprocessor (18), see Column 2 starting at line 44 and ending at line 47. This is taught by Lane in order to extend the duration of the emergency lighting to meet local statutory requirements, see Column 6 starting at line 58 and ending at line 63. In making the combination with Anderson, if the microprocessor of Anderson, in this case CPU 117, shuts down during battery operation as per the teachings of Lane (see Anderson, column 6, starting at line 33 and ending at line 47), Anderson's notebook computer 113 will not function. The prime motivation for utilizing mobile electronic devices is being able to operate while in transit from batteries when no AC power outlet is available. Accordingly, the use of Lane in combination with Anderson changes the principle of operation of Anderson. Thus, traversing the Examiner rejection of Applicant's claims.

(3) The Proposed Modification cannot render the prior art unsatisfactory for its intended purpose

Examiner's proposed combination of Lane and Anderson renders the operation of Anderson unsatisfactory for its intended purpose. In light of the reasons given *supra*, the use of Lane in combination with Anderson renders Anderson unusable for operation under battery power.

If the circuitry of Lane's teaching was to be modified to have the microprocessor (18) remain powered while supplying emergency lighting, in order to have Anderson's apparatus fully functional and operational as was intended while being powered by Battery, the emergency fixtures of Lane may not achieve the specified duration of providing emergency lighting for which they were manufactured due to the excess power used by the microprocessor (18) remaining powered during emergency use.

The Examiner's combination of Lane and Anderson renders either the first prior art reference or the second prior art reference unsatisfactory for its intended purpose. Thus, traversing the Examiner rejection of Applicant's claims per MPEP 2143.01.

Newly Added Claims

Claims 10-13 have been introduced as of this amendment and further define subject matter which is believed patentably distinct from the references cited. Independent Claims 10 and 13 newly recite "... in one of the formats selected from the group consisting of a line graph, a bar graph and value information." Support for Applicant's newly added claims can be found in Figures 6, 7 and 8, and in the Specification starting at the bottom of page 18

PATENT
IBM Docket No. JP9 1999 0748

and ending on page 19. Claims 11 and 12 depend variously from Claim 10, as such, Applicant believes they make contributions to the art within the scope of the present Application. Applicant believes Claims 10 -12 neither introduce new matter nor extend beyond the scope of the present application.

For the reasons given above, it is the position of Applicant that Claims 10-13 further define inventions which are patently distinct from the references cited, whether applied or not, under the tests of 35 USC 103. Should the Examiner conclude otherwise, it is respectfully requested that the Examiner's arguments be clarified in any next following Official Action in order that Applicants may more clearly understand the teaching which suggests obviousness of any combination of references.

Conclusion

In view of the foregoing it is believed that this case has been placed in condition for a notice of allowability and early notice to that effect is earnestly solicited. Should the Examiner wish to have a telephonic discussion of the positions here taken, the courtesy of a telephone call prior to any forthcoming rejection would be greatly appreciated.

Respectfully Submitted,



Carlos Munoz-Bustamante
Reg. No. 51,349

Customer No. 25299

(919)254-2587
FAX 919-254-2649